



60130-1064
98UK011

ITW AF
3682

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Colin

Serial No.: 09/830,096

Examiner: Van Pelt, Bradley J.

Filed: November 6, 2002

Group Art Unit: 3682

Title: ACTUATOR ASSEMBLY

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Sir:

Subsequent to Examiner's Answer mailed on September 8, 2004, Appellant now submits this Reply.

Appellant believes no further fees are required, however, if any additional fees or extensions are required, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds.

ARGUMENTS

- (1) Claims 9-15 is enabling under 35 U.S.C. § 112, first paragraph.

In Examiner's answer, the Examiner states that one skilled in the art could not make use of the invention because the shape of the housing is not described. However, the absence of shape of the housing is not relevant to providing proper support for the claimed invention. The overall shape of the housing is not what is claimed. Specific features of the housing are included in

the claims, however none of the claims are not limited to any particular shape or size housing. Examiner is improperly requiring additional limitations as to the shape of the housing that are not claimed, or necessary to understand the claimed invention. Accordingly, the rejection to claims 9-15 should be reversed.

Further, The Examiner stated that the summary of the invention is deficient as it refers to drawings that were not entered. Specifically, Examiner refers to Figure 3. Applicant refers to Figure 3 as “(Proposed Figures 1A, 1B, 1C, 3 and the first and second paragraphs on page 3).” Accordingly, the summary is a proper description of the invention. The matter contained within the proposed figures and the first and second paragraphs of page 3 of the specification within the specification were all disclosed such that a worker versed would be able to make and use the invention.

(2) Claims 1, 2, 3, and 16 are patentable under 35 U.S.C. § 102(b) over Ohkawa et al.

Examiner argues that the limitation in claim 1 that a pinion is *directly fixed* to a drive shaft to always rotate in unison with the drive shaft is the same as the shaft being driven by an electromechanical clutch (150) as is disclosed in Ohkawa et al. This is not the same and does not meet the limitations recited in claim 1.

Examiner argues that because in Ohkawa et al. the pinion gear (151) *can* be engaged to drive the shaft all the time that it also fulfills the *directly fixed* limitation. However, this is not the case. In Ohkawa et al., pinion (151) is not *directly fixed* to the output shaft (141) and is engaged through the electromechanical clutch (150). The Examiner argues that this therefore anticipates functional limitations in claim 1. (Final rejection dated December 12, 2003, section 8) However, the limitation “*a pinion directly fixed*” is a structural limitation that requires the pinion to be attached directly to the drive shaft in clear and certain terms. Ohkawa et al simply does not meet the structural limitation of *a pinion directly fixed* to a drive shaft. Accordingly, the rejection to claims 1,2,3 and 16 should be reversed.

(3) Claim 4 is patentable under 35 U.S.C. § 102(b) over Ohkawa et al.

Claim 4 depends from claim 1 and includes the limitation that the gear rack includes at least one stop to limit movement of the rack relative to the body portion. The Examiner identified straight sides (117) of the base frame (110) as being “stops” (Ohkawa et al. Figure 1). It is understood that the Examiner is to read claim limitations broadly. However, such interpretation must be within the understanding of a worker skilled in the art. The straight sides (117) of the housing are not stops but instead are merely sides of a housing within which the motor (140) operates. A worker versed in the art would not consider sides of a housing as stops, in that contact with the housing would not be desirable. Further, nothing in Ohkawa et al. suggests that the sides are used to stop or restrict movement of the motor. Accordingly, the rejection of claim 4 should be reversed.

(4) Claim 7 is patentable under 35 U.S.C. § 102(b) over Ohkawa et al.

The Examiner argues that Claim 7 is anticipated by an upper plate (112) and lower plate (113) (shown in Ohkawa et al Figure 2) as a guide portion. The upper plate (112) and the lower plate (113) merely cover portions of a housing protecting the motor (140) and are not guide portions. A worker versed in the art would not consider top and bottom portions of a housing as guide portion. Further, the Ohkawa et al disclosure provides no support or description of the upper and lower plates (112, 113) acting as a guide. Accordingly, the rejection to claim 7 should be reversed.

(5) Claim 8 is patentable under 35 U.S.C. § 102(b) over Ohkawa et al.

The Examiner argues that the limitation in Claim 8 that the guide portion is supported by each stop. The Examiner reads the side walls (117) as stops and that the upper and lower plates (112 and 113) are the guides. These structures in Ohkawa et al are merely part of a housing surrounding the motor (140) and nothing in Ohkawa et al. provides motivation to support the

interpretation as anything more than simply parts of a housing. The rejection to claim 8 should therefore be reversed.

(6) Claims 17-18 are patentable under 35 U.S.C. § 102(b) over Okhawa et al.

Examiner repeats the argument that the Okhawa et al. pinion (151) anticipates the claim limitation of a *pinion directly fixed* to a drive shaft. However, the pinion (151) disclosed in Okhawa et al is driven by an electro-mechanical clutch (150) through a typical clutch interface (Okhawa et al. Col. 4, lines 18-20). Such a driving configuration is simply not the same as being directly fixed to the drive shaft as is required to meet the limitations of claim 17. Therefore, the rejection to claim 17 is improper and should be reversed. Further, claim 18 depends from claim 17 and is therefore also allowable.

CONCLUSION

For the reasons set forth in this reply, the final rejection of claims 1-4 and 7-18 is improper and should be reversed.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

By: John M. Siragusa
John M. Siragusa
Reg. No. 46,176
W. Maple Road, Suite 350
Birmingham, MI 48009
(248) 988-8360

Dated: November 8, 2004

CERTIFICATE OF MAILING

I hereby certify that this reply brief (in triplicate) is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 8, 2004.

Amy M. Spaulding
Amy M. Spaulding